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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,255	08/22/2003	Adam G. Trubitt		9484

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EXAMINER

MILLER, BENA B

ART UNIT PAPER NUMBER

3712

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/646,255

Applicant(s)

TRUBITT, ADAM G.

Examiner

Bena Miller

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1, 4, 5, 10, 11, 14, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein.

Klein teaches in figures 1-6 an inflatable volume (11,12) and an expandable figurine that is attached to the inflatable volume such that the figurine is stretched as the volume is inflated (col. 2, lines 26-62).

Regarding claims 4 and 14, Klein further teaches the figurine has a differential construction such that different portions of the figurine have a different propensity to expand, such that the figurine is stretched in a differential manner as the volume is inflated (col. 2, lines 26-62; fig. 1 and 3).

Regarding claims 5 and 15, Klein further teaches the expandable figurine has a bottom surface that is adhesively attached to the inflatable volume (col. 2, lines 26-62).

Regarding claims 10 and 18, Klein further teaches the expandable figurine assumes a first predetermined shape when the inflatable volume is in a deflated state, and assumes a different shape representing a distortion of the first predetermined shape when the inflatable volume is substantially inflated (fig. 1 and 3).

Regarding claim 11, Klein teaches in figures 1-6 the toy method comprising the steps of providing an inflatable toy and an expandable figurine that is attached to the outer surface of an inflatable volume (11,12) and inflating the inflatable volume and

Art Unit: 3712

stretching the figurine as the inflatable volume is inflated (col. 2, lines 26-62; fig. 1 and 3).

Claims 1-3, 8 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Guzman.

Guzman teaches in figures 1-4 an inflatable volume (10) and an expandable figurine that is attached to the inflatable volume such that the figurine is stretched as the volume is inflated (28, 30, 46, 54, 66).

Regarding claims 2 and 12, Guzman further teaches a body portion having multiple limbs, such that the figurine is attached to the inflatable volume outer surface (fig. 1).

Regarding claims 3 and 13, Guzman further teaches the figurine having a differential construction such that different portions of the figurine have a different propensity to expand (fig. 1).

Regarding claim 8, Guzman further teaches a latex balloon (col. 1, lines 49 and 50).

Regarding claim 11, Guzman teaches in figures 1-4 the toy method comprising the steps of providing an inflatable toy and an expandable figurine that is attached to the outer surface of an inflatable volume (10) and inflating the inflatable volume and stretching the figurine as the inflatable volume is inflated (28, 30, 46, 54, 66; fig. 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3712

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein.

Klein teaches in the figures most of the elements of the claimed invention except for the figurine removably attached to the inflatable volume. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the figurine removably attached to the inflatable volume, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Guzman.

Klein teaches in the figures most of the elements of the claimed invention except for a rubberized shape expandable figurine. Guzman teaches an inflatable play toy having a rubberized shape (col. 2, lines 49 and 50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a rubberized shape as taught by Guzman for the expandable figurine of Klein for the purpose of providing a non-skid relatively stationary base (col. 1, line 21).

#### ***Allowable Subject Matter***

Claim 17 is allowable.

#### ***Response to Arguments***

Applicant's arguments filed 04/05/04 have been fully considered but they are not persuasive. In response to applicant's remarks that Klein fails to teach an expandable figurine attached to an inflatable volume, the examiner disagrees. As broadly recited in claim, "an expandable figurine attached to an inflatable volume", the examiner takes the position that Klein teaches an inflatable volume (11 and 12) as shown in fig. 6 and the expandable figurine (14), also seen in fig. 6. As 11 and 12 is inflated, 14, a part of the gorilla, expands. Therefore, Klien meets claim 1 of the claimed invention. Further, it is agreed that Klien teaches the inflatable structure is attached to a rigid panel; however, the applicant is contending that the expandable figurine is attached to an outer surface of an inflatable volume. As noted above, Klien teaches the limitations.

In response to applicant's remarks that Guzman fails to teach an inflatable volume and an expandable figured that is attached to the inflatable volume. As noted above in the rejection, Guzman teaches, as broadly recited, an inflatable volume (10) and expandable figurine that is attached to the inflatable volume. It should be noted that once 10 is inflated, 28, 30, 46, 54 and 66 is expanded therefrom. Although the may be in communication with each other, it should be noted that applicant did not claim the expandable figurine to be non-inflated. Therefore, the examiner takes the position that Guzman teaches the limitations.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 703.305.0643. The examiner can normally be reached on Monday-Friday.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbm  
June 28, 2004



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